



Attorney Docket No. P-2821R1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:
James NADEAU et al.

Reissue of U.S. Patent No.: 5,547,861

Group Art Unit: 1637

Application No.: 09/082,247

Examiner: Joyce TUNG

Filed: May 20, 1998

Title: DETECTION OF NUCLEIC ACID AMPLIFICATION

PETITION UNDER 37 C.F.R. §1.181/1.127

AND

REQUEST FOR WITHDRAWAL OF NOTICE OF NON-COMPLIANT AMENDMENT

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petition, pursuant to 37 CFR §1.181 and §1.127, to enter the Response Pursuant to 37 CFR §1.111 of April 26, 2005 and the Response of September 6, 2005, and concurrently request withdraw of the Notices of Non-Compliant Amendment pursuant to 37 CFR §1.121 of September 22, 2005 and May 5, 2005. The basis for both the petition and the Request are set forth below.

STATEMENT OF PERTINENT FACTS

The present application is a Reissue application filed pursuant to 35 USC §251. The present application was filed on May 20, 1998.

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A non-final official action having a mailing date of October 26, 2004 was issued by Examiner Tung.

A response to the October 26, 2004 official action was prepared and filed pursuant to 37 CFR §1.111 on April 26, 2005. In the response filed on April 26, 2005 amendments were made to claims 21 and 29. The response filed April 26, 2005 also included a Status of the Claims section.

A Notice of Noncompliant Amendment was subsequently mailed on May 5, 2005. In the May 5, 2005 notice the response filed on April 26, 2005 was denied entry on the grounds that it failed to comply with the requirements of 37 CFR §1.121.

A response to the May 5, 2005 Notice of Non-Compliant Amendment was then prepared and filed on September 6, 2005. It is indicated in the September 6, 2005 Response, that applicants' representative (Alan M. Kiang, registration number 42,275) contacted Legal Instruments Examiner Katrina Turner on May 20, 2005 to request withdrawal of the May 5, 2005 Notice of Noncompliant Amendment. Is further indicated in the September 6, 2005 response that Legal Instruments Examiner Turner represented that the May 5, 2005 Notice would be withdrawn.

However, instead of withdrawing the May 5, 2005 Notice, a second Notice of Non-Compliant Amendment was then issued on September 22, 2005. In the September 22, 2005 Notice, the response filed on September 6, 2005 was also denied entry on the grounds that it failed to meet the requirements of 37 CFR §1.121. The present Petition and Request for Withdrawal is being filed in response to at least the September 22, 2005 Notice, which appears to

be a final decision by the Patent Office and which denied the previous request for withdrawal noted above.

BASIS FOR REQUESTED RELIEF

The present application is a Reissue application filed pursuant to 35 USC §251. Thus, as explicitly set forth in 37 CFR §1.121: "any amendment to the description and claims in reissue applications must be made in accordance with §1.173." The provisions of 37 CFR §1.121 are completely inapplicable to the amendments filed during prosecution of the present application. Thus, the notices of May 5, 2005 and September 6, 2005 are deficient on their face, and incorrect as a matter of law.

The amendment filed April 26, 2005 has still not been evaluated under the appropriate standard, namely, the requirements of 37 CFR §1.173. The pertinent requirements of 37 CFR §1.173 are set forth below:

(2) Claims. An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim. . . .

(c) Status of claims and support for claim changes. Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) Changes shown by markings. Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or

by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

When judged according to the correct legal standard, the Response filed April 26, 2005 as well as the Supplemental Response filed on September 6, 2005, are both clearly in conformance with the requirements of 37 CFR §1.173.

The continued denial of entry of these responses on the basis of the requirements of 37 CFR §1.121 is clearly inappropriate.

RELIEF REQUESTED & CONCLUSION

In light of the above, Applicants petition, pursuant to 37 CFR §1.181 and 37 CFR §1.127, the decision to deny entry of the Responses filed April 26, 2005 and September 6, 2005, and ask that prosecution on the merits continue on the basis of the amendments contained therein.

Applicants further request that the Notice of Non-Compliant Amendment with a mailing date of September 22, 2005 be withdrawn, as it is clearly defective on its face and incorrect as a matter of law.

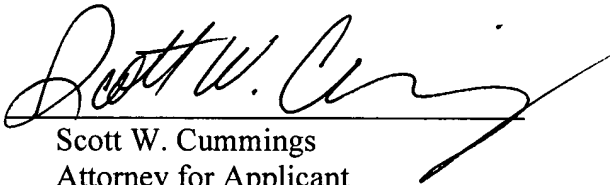
To the extent that it is determined that relief is inappropriate pursuant to the above, Applicants hereby request that this submission be considered as a petition under 37 C.F.R. §1.182 and/or §1.183.

A petition fee pursuant to 37 C.F.R. § 1.17 is submitted herewith.

Should this petition be considered insufficient, or the relief requested not be granted for any reason, Applicants respectfully request that this be considered a *bona fide* attempt to respond to the Notice of Non-Compliant Amendment dated September 22, 2005, and that Applicants be permitted an opportunity to supplement this response. Any fee deficiency, as well as any overpayment, may be applied to Deposit Account 50-2228.

Respectfully submitted,

Date January 20, 2006

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